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PETITION
EXPEDITED PROCEDURE
EXAMINING ART UNIT 3617

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: James George Allen et al
Serial No.: 10/751,620 Art Unit: 3617
Filed: January 6, 2004 (Robert J. McCarry, Jr.)
Title: Control Device For A
Railroad Car

FAX 571-273-8300

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION UNDER 37 CFR 1.181 TO COMMISSIONER
FOR SUPERVISORY REVIEW

Dear Sir:

Applicants petition for withdrawal of the Final Rejection (FR) of January 30, 2006, clarification of various portions of the FR of January 30, 2006, and a new period for response to be set with a new and complete Office Action.

STATEMENT OF FACTS

1. Page 4 of the FR stated: "Applicant's (sic) amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a)." However, claim 32, one of the two independent claims rejected, was not amended as is clear from page 22 of the Amendment (AM), filed November 14, 2005, in which claim 32 is identified as "Previously Presented."

MPEP §706.07(a) sets forth in part:

". . . a second or any subsequent action on the merits in any application . . . will not be made final if it includes a rejection, on newly cited art, . . . of any claim not amended by applicant . . . in spite of the fact that other claims may have been amended to require newly cited art." (emphasis added)

Thus, MPEP §706.07(a), which the Examiner referenced, does not support his statement on page 4 of the FR.

It is difficult to understand how the Examiner failed to observe that claim 32 was not amended in view of his having to read the claim to make the new ground of rejection.

2. Page 4 of the FR also said: "Applicant's (sic) arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection." However, this is in error since arguments were made relative to only claims 1, 2, 32, and 33.

Furthermore, despite the new ground of rejection, there are still arguments presented in the AM that are not moot because the new ground of rejection does have any effect on these arguments since Werley has no relation thereto.

Werley sets forth in lines 20-23, column 2: "it would be desirable to have a pressure regulator that would automatically shut off upon failure of the pressure sensing/control element so as to prevent release of any gas which can cause safety problems." (emphasis added) This is what the invention of Werley relates to as also stated in lines 9-13, column 1.

Accordingly, one of the requirements concerning motivation is the applied art. Regulators that automatically shut off for failure of the control element are not relevant art to a control

element for preventing air from acting on a piston in a housing in the first direction to move the piston in a housing to a door opening position until the air pressure exceeds a predetermined pressure (claim 1) or a control element for preventing movement of a piston in a housing to its door opening position at the predetermined position along its predetermined travel path until a predetermined air pressure in the housing is exceeded (claim 32). There is nothing concerning failure of the control element in applicants' claimed invention or Rosenbaum.

MPEP §707.07(f) provides in part:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. (emphasis added)

Although the rejection in the prior Office Action was not repeated per se, the new ground of rejection merely added the only complete paragraph on page 3 of the FR to the prior Office Action. While it is a new ground of rejection, it still includes the prior rejection to which Werley has no relation. The addition of Werley has no effect on the doors being opened, not closed, in the following arguments relating to claims 1, 2, 32, and 33.

In the paragraph bridging pages 26 and 27 of the AM, the final sentence set forth: "Therefore, the limitation of claim 1 for preventing air pressure from acting in the first direction not only differs from Rosenbaum by the pressure exceeding a predetermined air pressure before the piston in the housing is moved but this occurring to open the doors, not close the doors

as occurs in Rosenbaum." This argument is not moot since there is no teaching in newly cited Werley to modify Rosenbaum to open the doors; Rosenbaum closes the doors as discussed whereas claim 1 requires the doors to be opened. Therefore, since Werley is used by the Examiner solely to disclose a control element not movable until a predetermined pressure is reached as stated in lines 9-11 of the only complete paragraph on page 3 of the FR, this argument is not moot.

Likewise, the first complete paragraph on page 27 of the AM discusses why claim 32 differs from Rosenbaum, which has movement of its door to a closing position, not a door opening position as claim 32 recites. This argument also is not moot since Werley is relied upon solely by the Examiner to disclose a control element not movable until a predetermined pressure is reached as stated in lines 9-11 of the only complete paragraph on page 3 of the FR. 3. The final complete paragraph on page 27 of the AM quoted the final sentence in the paragraph bridging pages 2 and 3 of the Office Action of September 29, 2005. This exact sentence is in the same location in the FR.

The paragraph bridging pages 27 and 28 of the AM said that the pilot valve 156 was not responsive to pressure but to movement of a solenoid 232. In fact, the final sentence of the bridging paragraph stated: "The Examiner agreed during the telephone interview of October 19 that the pilot valve 156 was not pressure responsive."

The Examiner has not denied this statement in the FR, and he said on page 4 of the FR that he considered the arguments. He also has not denied that he said during the telephone interviews on October 28, 2005 that claims 2 and 33 were possibly allowable as set forth in the paragraph bridging pages 31 and 32 of the AM.

This argument concerning the pilot valve 156 has not been made moot by the new ground of rejection. Instead, as previously mentioned, the Examiner has continued to repeat the simply incorrect statement concerning the operation of the pilot valve 156 of Rosenbaum in the final sentence of the paragraph bridging pages 2 and 3 of the FR. There is no factual basis for this erroneous statement.

Furthermore, the only complete paragraph on page 28 and the paragraph bridging pages 28 and 29 of the AM clarified for the Examiner why the pilot valve 156 is not pressure responsive in that opening of doors 34 and 36 of Rosenbaum occurs only upon actuation of a solenoid 188. Werley has no relation to this argument since it is concerned with a pressure regulator.

4. The only complete paragraph on page 29 of the AM explained that movement of the pilot valve 156 to its second state did not allow air or fluid to flow to the piston 142, as the final sentence of the paragraph bridging pages 2 and 3 of the September 29, 2005 said, but stopped flow of air. However, the Examiner has continued to make this simply incorrect statement in the same location in the FR. This argument is not moot because the FR should not repeat the simply incorrect statement.

5. Additionally, the paragraph bridging pages 29 and 30 of the AM explained to the Examiner that the pilot valve 156 is not capable of controlling movement of the doors 34 and 36 to the open position, and this is a limitation of the rejected claims. It is not understood how the Examiner considers this argument to be moot since he continues to incorrectly state in lines 5-8, page 3 of the FR that the operation of the pilot valve 156 is responsive to pressure even though he admitted that it was not during the telephone interview on October 19, 2005.

6. There has been no response to the argument concerning claim 2 in the paragraph bridging pages 30 and 31 and the first complete paragraph on page 31 of the AM. That is, Werley has no pressure responsive element between the source of air pressure and the piston since diaphragm (the control element) 26 of Werley could be replaced by a piston to be a pressure responsive element, but it is not between the source of air pressure and another piston to block supply of air pressure in the first direction. In fact, there is no discussion in Werley of any use of the pressure regulator in the art of the present invention. Similarly, the arguments concerning claim 33 are set forth in the final complete paragraph on page 31, the paragraph bridging pages 31 and 32, and the first complete paragraph on page 32 of the AM, but these are not moot because of the addition of Werley.

7. The Examiner has not changed his position concerning Ward so that the arguments concerning the modification of Rosenbaum by Ward are not moot, and Werley has no effect on this modification

of Rosenbaum by Ward. These arguments are found on pages 33-37 of the AM.

8. The September 1, 2005 decision by the Director, Technology Center 3600, stated:

"With regard to items 1 and 2 above, it appears that the Office action does satisfy the minimum requirements for a properly constructed rejection, and therefore petitioner is not entitled to the requested relief based on these grounds. The examiner has clearly set forth in the rejection and arguments how the claim is being interpreted, how the reference meets the claim based on this interpretation, and how the references are being combined. While petitioner takes exception with the examiner's interpretation and explains such in the arguments, the correctness of a rejection is subject matter for appeal and not petition. Similarly, the examiner is not required to point out explicit motivation in the references by page and line number, but need only supply a motivating factor for the combination based on the evidentiary record and state of the art as a whole. The fact that petitioner provides lucid and well reasoned arguments rebutting the examiner's interpretation and combination clearly shows that the petitioner understands how the examiner is applying the art but simply does not agree with its application. Upon successful appeal, petitioner is entitled to the relief of a reversal of the rejection, but is not entitled to a new Office action or withdrawal of finality. (emphasis added)

The decision stated that the Examiner has clearly set forth how the references are being combined. It is respectfully contended that the Examiner has not complied with MPEP §2143.01 IV on page 2100-137) and In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) on page 2100-135 (right column) wherein motivation to combine references requires (1) nature of problem to be solved, (2) teaching of prior art, and (3) knowledge of one of ordinary skill in the art for an implicit showing.

For an explicit showing, In re Kotzab at 1317 states: "The motivation, suggestion, or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary

skill in the art, or, in some instances the nature of the problem to be solved."

9. The Director said that the Examiner is not required to point out explicit motivation in the references by page and line number. However, MPEP §706.02(j) on page 700-47 states in part:

"After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(D) an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. (emphasis added)

This is not what was stated in the Director's decision as to page and line number. It is submitted that applicants are entitled to have the Examiner comply with (A) and (D).

Thus, MPEP §706.02(j) requires three basic criteria that must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. There is no suggestion in Rosenbaum and/or Werley of so modifying Rosenbaum by the

structure of Werley. The source of air pressure in Rosenbaum is air reservoir 154, and this is the only location that the regulator of Werley could be substituted in Rosenbaum. However, this would not enable the control element (diaphragm 26) of Werley to prevent air pressure from acting in the first direction on the piston 142 of Rosenbaum until the air pressure exceeds the predetermined air pressure. Even if the regulator of Werley were substituted in Rosenbaum for the air reservoir 154, it supplies constant pressure of some selected value in the same manner as the air reservoir 154.

MPEP §706.02(j) also requires that the prior art reference or references when combined must teach or suggest all of the claim limitations. As previously pointed out, the control element of claim 1 prevents air pressure from acting in the first direction on the piston to cause movement of the door to its open position until the air pressure exceeds a predetermined air pressure. However, as stated in prior Amendments and telephone interviews with the Examiner, Rosenbaum uses the air pressure to close the doors, not open them as claim 1 requires. Thus, all of the claim limitations are not found in Rosenbaum as modified by Werley. The Examiner has continued to not disclose where this limitation is found in Rosenbaum.

MPEP §707.07(f) provides in part:

an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application. (emphasis added)

Accordingly, it is urged that the Examiner has a duty to set forth where each claim element is found, notwithstanding the apparent opposite position of the Director in his September 1, 2005 decision that the Examiner does not have to be specific where claim limitations are found in the references. It is submitted that this is contra to the MPEP, particularly §706.02(j) and §707.07(f). Under MPEP §707.07(f), applicants are entitled to a clear explanation from the Examiner of where a claim limitation is found in the reference when Rosenbaum uses the control element to close, not open, the doors.

10. Lines 2 and 3 of the only complete paragraph on page 3 of the FR ignores the limitations of claims 1 and 32 in stating: "Rosenbaum does not specifically show a control element for preventing air pressure from acting on the piston until the pressure exceeds a predetermined pressure." Claim 1 recites a control element for preventing air pressure from acting in the first direction (This first direction opens the doors.) on the piston until the air pressure exceeds a predetermined air pressure." Claim 32 requires a control element for preventing movement of the piston to its door opening position at the predetermined position along its predetermined travel path until a predetermined air pressure in the housing is exceeded. Werley has nothing to do with the emphasized limitations.

Werley states that a regulator 10 must have an enclosed bonnet 24 on the side of a control element (diaphragm 26) opposite a low pressure chamber 16 with the gas pressure in a sealed chamber 32 of the bonnet 24 being greater than the highest pressure which can be expected in the low pressure chamber 16 and is the delivery pressure. (see lines 15-20, column 5). The Examiner has made no explanation of how the control element 26 of Werley can be responsive to a predetermined air pressure since it is subject to a pressure greater than the highest pressure in the low pressure chamber. That is, as set forth in lines 25-29, column 5 of Werley, the delivery pressure in the low pressure chamber 16 and the force exerted by the spring 30 on the control element 26 balance the force applied by the gas pressure in the sealed chamber 32 on the control element 26. The Examiner has not made a clear explanation as required by MPEP §707.07(f).

11. In lines 5-7 of the only complete paragraph on page 3 of the FR, the Examiner stated: The passages (inlet passage 20 connected to high pressure chamber 14 and outlet passage 22 connected to low pressure chamber 16) are separated by a moveable control element (26), which is connected to a bonnet (24) by a spring (30). (numbers added) This sentence is simply incorrect because the control element 26, which is connected by the spring 30 to the bonnet 24, separates the low pressure chamber 16, which has the outlet passage 22 as the Examiner set forth, and the sealed chamber 32 of the bonnet 24. Instead, the passages 20 and 22 of Werley are separated from each other by an orifice 18 connecting

the high pressure chamber 14 and the low pressure chamber 16 (see lines 59-61, column 2). Therefore, the Examiner has not complied with MPEP §707.07(f) in that there is no clear explanation of his position.

The entire concept of Werley is found in lines 35-39, column 5 wherein it is stated that in the event of any leakage across the control element 26, either by rupture or any other reason, the gas in the bonnet 24 will cause the regulator 10 to close. This operation would not function in Rosenbaum.

12. The Examiner said in lines 7-9 of the only complete paragraph on page 3 of the FR: "When the bonnet fills with the compressed gas and a force is applied to the control element and this force then opens the regulator when the force overcomes the predetermined spring force." (emphasis added)

First, this sentence is not in accord with lines 8-10, column 3 of Werley because the bonnet 24 is completely enclosed to form the sealed chamber 32 and is always filled with a gas. The gas pressure in the sealed chamber 32 acts on the control element 26 to control the pressure of the gas passing through the regulator as stated in lines 31-45, column 5.

It also is submitted that there is no basis in Werley for the Examiner to state that a force is applied to the control element 26 and that this force opens the regulator when this force overcomes the predetermined spring force. Instead, when the regulator 10 is set to zero delivery pressure, the force of

the gas in the sealed chamber 32 of the bonnet 24 is balanced by the force of the spring 30.

When the force of the spring 30 is reduced by rotating the adjustment knob 28, the control element 26 moves to the left in FIG. 1 to overcome the force of a spring 40 to move a valve seating surface 38 of a valve plug 34 away from the orifice 18. This allows air pressure to flow from the source through the inlet passage 20 into the low pressure chamber 16 to act on the control surface of the control element 26. The amount of movement of the valve plug 34 is controlled by the position of the control element 26 due to the pressure in the low pressure chamber 16 and the force of the spring 30 balancing the gas force in the bonnet 24 (See lines 26-49, column 3.) The movement of the spring 30 by the adjustment knob 28 reduces the force of the spring 30 to cause the regulator 10 to open to produce the desired delivery gas pressure.

No force can be applied to the control element 26 to open the regulator 10 when the force overcomes the predetermined spring force as the Examiner said in lines 7-9, page 3 of the FR. Instead, the adjustment of the spring force by changing the length of the spring 30 by rotating the adjustment knob 28 allows the control element 26 to be moved by the gas pressure in the sealed chamber 32 of the bonnet 24.

His statement in line 9 of the only complete paragraph on page 3 of the FR refers to a predetermined spring pressure, not a predetermined air pressure as the rejected claims require.

Accordingly, the Examiner's statement in lines 9 and 10, page 3 of the FR that the control element 26 does not move until a predetermined pressure is reached so as to move the spring 30 is not understood.

Therefore, the Examiner has not complied with MPEP §707.07(f). Clarification is respectfully requested.

13. The explanation of motivation for combining Rosenbaum and Ward on page 4 of the FR is not believed to be in accord with MPEP §2143.01 IV on page 2100-137 and In re Kotzab, 55 USPQ2d 1313, 1317 (CAFC, 2000) on page 2100-135 wherein the court stated that motivation requires (1) problem solved, (2) teaching of prior art, and (3) knowledge of persons of ordinary skill in the art for an implicit showing. The final complete paragraph on page 36 of the AM sets forth what In re Kotzab requires for an explicit showing. This argument is not moot because of the new ground of rejection. The Examiner must identify whether he is relying on explicit or implicit motivation to enable an understanding of his contention.

In the AM, the bridging paragraph on pages 36 and 37 and both complete paragraphs (particularly the second) on page 37 explain that neither patent (Rosenbaum nor Ward) has any suggestion of recognizing or solving the problem of insuring that material within the railroad car is released by opening the door when the air pressure exceeds a predetermined amount and that inadvertent opening of the door can occur prior thereto. This is discussed in line 25, page 1 - line 26, page 2 of the

application. Thus, there is no motivation as "problem solved" is one requirement for an implicit showing.

14. MPEP §706.02(j) sets forth in the final complete paragraph, left column on page 700-48 that the prior art must teach or suggest all the claim limitations and that the combination must not be based on applicants' disclosure but must be found in the prior art. The first paragraph of MPEP §2143.03 also requires that all the claim limitations must be taught or suggested by the prior art.

There has been no compliance by the Examiner with MPEP §706.02(j) since there is no suggestion or motivation to modify Rosenbaum by Ward. The references must expressly or impliedly suggest the claimed invention, and they do not.

Claim 32, for example, is limited to the material being released only when the railroad car is at a predetermined position along its predetermined travel path. Ward teaches away from this since the material is selectively discharged at several points as stated in the third complete paragraph on page 37 of the AM.

There also has been no showing that all the claim limitations are taught or suggested by the prior art. Accordingly, there has been no compliance with MPEP §706.02(j) or §2143.03.

POINTS TO BE REVIEWED

1. The Examiner has not complied with MPEP §706.07(a) in that claim 32 is not amended as discussed in section 1 of STATEMENT OF FACTS so that the Final Rejection is not proper.
2. The Examiner has not complied with MPEP §707.07(f) since there has been no response to the arguments in the AM as set forth in sections 2-7 of STATEMENT OF FACTS and the arguments were not rendered moot by the new ground of rejection because the addition of Werley with Rosenbaum and Ward to form the new ground of rejection has no relation to these arguments as these arguments are not changed by the addition of Werley.
3. The Examiner has not complied with MPEP §2143.01 IV for the reasons set forth in sections 8 and 13 of STATEMENT OF FACTS.
4. The Examiner has not complied with MPEP §706.02(j) and §707.07(f) for the reasons set forth in section 9 of STATEMENT OF FACTS.
5. The Examiner has not complied with MPEP §707.07(f) for the reasons set forth in sections 10-12 of STATEMENT OF FACTS.
6. The Examiner has not complied with MPEP §706.02(j) or §2143.03 for the reasons set forth in section 14 of STATEMENT OF FACTS.

ACTION REQUESTED

It is respectfully requested that the Final Rejection be withdrawn, a new Office Action be issued with a new response date including response to the arguments in the AM, clarification of the Examiner's positions as discussed in sections 2-14 of STATEMENT OF FACTS, and compliance with MPEP §706.02(j), §707.07(f), §2143.01 IV, and §2143.03.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571)-273-8300 on February 13, 2006.

By Frank C. Leach Jr.
Date February 13, 2006